

REMARKS

Claims 73-118 are pending in this patent application and have not been amended. Those claims were rejected under the doctrine of obviousness-type double patenting over claims 1-25 of commonly-assigned U.S. Patent 6,618,114 (hereinafter "the '114 patent"). Applicant respectfully traverses this rejection for at least the following reasons.

In making the rejection, the Examiner asserts that "although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter." In response, Applicant respectfully submits that the Examiner has performed the obviousness-type double patenting analysis improperly, and that the rejection itself is improper.

First and foremost, Applicant submits that the legal analysis that must be performed is a comparison of the claims of the present application with the claims of the '114 patent. As stated in MPEP § 804(II)(B)(1), "the first question to be asked is – does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent?" Furthermore, "the disclosure of the patent may not be used as prior art."

Specifically, the proper legal analysis for an obviousness-type double patenting rejection parallels the analysis used for a rejection under 35 U.S.C. § 103(a), but is restricted to the claims of the application and the claims of the patent. As stated in MPEP § 804(II)(B)(1), the steps of the analysis are as follows:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;

- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The MPEP also states that “an obviousness-type double patenting rejection should make clear...the differences between the inventions defined by the conflicting claims.”

In view of the above, Applicant respectfully submits that the Examiner’s analysis is incomplete, insofar as it neglects at least point (B). More particularly, the Examiner offers no comparison of the claims in the ‘114 patent and the claims in the present application. The material following the assertion regarding “claiming common subject matter” appears to be the Examiner’s attempt to list certain features recited in the claims of the present application. However, a mere listing of certain features allegedly recited in the application claims does not constitute a comparison of those features with the features recited in claims 1-25 of the ‘114 patent. Applicant submits that the Examiner has not compared each and every feature of the application claims with the claims of the ‘114 patent.

Applicant notes, merely for the sake of example, that claim 73 of the present application recites “one or more polymer initializing and/or enhancing elements.” However, that feature is nowhere to be found in independent claim 1 of the ‘114 patent; furthermore, the claims of the ‘114 patent do not suggest it. For at least that reason, Applicant submits that the claims of the ‘114 patent are directed to entirely different features—and a different invention—than the claims of the present application.

Furthermore, Applicant respectfully submits that what may or may not be “fully disclosed” in the ‘114 patent is, in this case, irrelevant to whether or not the claims of the present application are obvious over the claims of the ‘114 patent. It appears to Applicant that the Examiner is improperly using the ‘114 patent as prior art.

The logical flaw in the Examiner's argument is in asserting that the claims of a patent and a patent application that recite some "common subject matter" are necessarily involved in obviousness-type double patenting. Applicant respectfully submits that that is manifestly not the case. For example, an earlier patent may include claims that are broader than the claims in a later patent application without invoking the doctrine of obviousness-type double patenting because the inventor may have included features in the later application claims that are in no way obvious from the claims of the earlier patent. Stated otherwise, a later patent application claim is not subject to the doctrine of obviousness-type double patenting merely because it is dominated by or shares "common subject matter" with the claims of an earlier patent. Moreover, and aside from the above example, the earlier patent and the later patent application, even though they disclose and claim some "common subject matter," may have claims directed to entirely different features and entirely different inventions, as is the case here.

As set forth in the Office Action itself, the doctrine of obviousness-type double patenting applies only when a patent and a patent application claim the same invention so as to create an "improper timewise extension of the 'right to exclude' granted by a patent." Whether or not the claims of a patent and the claims of an application are obvious over one another is determined by the analysis set forth above. The "common subject matter" standard that the Examiner has applied here is inexact, nebulous, improper, and deviates wildly from the established case law and U.S. Patent and Trademark Office policy. Claims 73-118 clearly do not recite the same invention as that claimed in the '114 patent. Accordingly, Applicant respectfully requests that the rejection of claims 73-118 be withdrawn.

Request for Acknowledgement of Claim for Domestic Priority

Applicant notes that the Office Action Summary (Form PTOL-326) does not provide an acknowledgement of Applicant's claims for domestic priority under 35 U.S.C. §§ 119(e) and 120. The specific reference required by 37 C.F.R. § 1.78 was made in a Preliminary Amendment filed with the application; therefore, Applicant respectfully submits that the requirements for the claim to priority have been satisfied. Accordingly, Applicant respectfully requests an acknowledgement of the claim to priority with the next Office communication.

Request for Return of Initialed Forms PTO-1449

Applicant notes that the Examiner has not returned initialed copies of the Forms PTO-1449 filed with an Information Disclosure Statement on October 9, 2003. Applicant respectfully requests that the cited references be made of record and that the Examiner return initialed copies of the forms, as required by MPEP § 609.

CONCLUSION

Applicant believes that a full and complete response has been made to the pending Office Action and respectfully submits that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicant respectfully submits that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicant's undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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